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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/552,400	10/07/2005	Tsutomu Kawakatsu	TOW-129USRCE	9270

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LAHIVE & COCKFIELD, LLP  
FLOOR 30, SUITE 3000  
ONE POST OFFICE SQUARE  
BOSTON, MA 02109

EXAMINER
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MACARTHUR, VICTOR L

ART UNIT	PAPER NUMBER
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3679

MAIL DATE	DELIVERY MODE
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02/25/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<i>Office Action Summary</i>	Application No. 10/552,400	Applicant(s) KAWAKATSU ET AL.	
	Examiner VICTOR MACARTHUR	Art Unit 3679	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2009.  
2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-5,7-15 and 17 is/are pending in the application.  
4a) Of the above claim(s) 2-5 and 9-12 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1,7,8,13-15 and 17 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/26/2009 has been entered.

### *Election/Restrictions*

Claims 2-5 and 9-12 remain withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made without traverse in the reply filed on 4/10/2008.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1, 7, 8, 13-15 and 17 are rejected under 35 U.S.C. 103(a) as obvious over Goto (U.S. Patent 5,989,124) in view of Batt (U.S. Patent 3,239,291), Scribner (U.S. Patent 1,982,932), and Swart (U.S. Patent 1,907,015).

Art Unit: 3679

Claims 1, 8 and 13-15. Goto discloses (figs.25-32) a constant velocity universal joint comprising a cylindrical outer member (1) which is connected to one transmission shaft and which is provided with a plurality of guide grooves (grooves in 1 receiving 72) separated from each other by predetermined distances and extending in an axial direction on an inner circumferential surface, and an inner member (4) which is inserted into an open inner space of said outer member and which is connected to the other transmission shaft, said constant velocity universal joint including: a plurality of trunnions (55) which are expanded toward said guide grooves; ring-shaped roller members (72) which contact said guide grooves and which are externally fitted to said trunnions; and a plurality of rolling members (6) which are interposed rollably between said trunnions and said roller members.

- Each of Batt (grease or oil based wax, wax bath cooled to solid), Scriebner (hard wax, paraffin or other wax), and Swart (bee's wax, carnauba paste wax, etc) teach that it is very desirable to use a wax (paste or solid) to hold rollers in place during assembly and then remove the wax to form the final product since such practice simplifies assembly. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Goto to use wax for the purpose of simplifying assembly.
- It has generally been recognized that selection of a known material based upon its suitability for the intended use is a design consideration within the skill of the art. In re Leshin, 227 F.2d 197, 125 USPQ 416 (CCPA 1960). Furthermore, the applicant has failed to demonstrate criticality by any showing of unexpected result derived from any specific wax consistency. Note applicant's specification and claims (claim 1 vs.

Art Unit: 3679

claim 8) state that either of solid or paste wax are usable. Wherein a specific limitation has no criticality, case law can be relied upon as the sole rationale in an obviousness rejection. See MPEP 2144.04. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to use a paste consistency wax (regarding claims 1, 13 and 14) or a solid consistency wax (regarding claims 8 and 15) since the art shows them to be equivalents for bearings and further since the limitation has no criticality and has thus been established by the case law cited above to be an obvious design consideration within the skill of the art. “[T]he results of ordinary innovation are not the subject of exclusive rights under the patent laws. Were it otherwise patents might stifle, rather than promote, the progress of useful arts. See U.S. Const., Art. I, section 8, cl.8.” In re KSR International Co. v. Teleflex Inc., 82 USPQ2d 1385 (U.S. 2007).

- wherein said paste wax comprises an oil/fat component which is inherently capable of use with a lubricating grease of higher consistency. Note the limitation “to be enclosed” (last line of claim 1) indicates that the lubricating grease is merely intended to be used with the joint and therefore does not structurally limit the joint; or overcome prior art that is fully capable of such a thick consistency lubricating grease. Furthermore the prior art wax structure is presumed to inherently have the applicant's claimed properties in accordance with MPEP 2112.01.
- Said wax is inherently capable of use with a lubricating grease and joint boot that do not chemically react with the wax (i.e., an inert boot and grease). Note that claim 8 does not state that the joint is structurally limited by a joint boot or lubricating grease

Art Unit: 3679

- but rather merely states (last lines of claim 8) that a boot and grease (i.e., some boot and grease not necessarily comprised within the joint) don't react with the wax. Not only are the boot and grease material not specified but no contact with the wax is claimed (e.g., a wax and grease/boot that are kept separate will not chemically react regardless of material choice). Furthermore the prior art wax structure is presumed to inherently have the applicant's claimed properties in accordance with MPEP 2112.01.
- Even if the prior art material did not inherently possess applicant's claimed properties, it appears that the claimed properties have no criticality. Wherein a specific limitation has no criticality, case law can be relied upon as the sole rationale in an obviousness rejection. See MPEP 2144.04. It has generally been recognized that selection of a known material based upon its suitability for the intended use is a design consideration within the skill of the art. In re Leshin, 227 F.2d 197, 125 USPQ 416 (CCPA 1960). Since the limitation has no criticality and has thus been established by the case law cited above to be an obvious design consideration within the skill of the art. "[T]he results of ordinary innovation are not the subject of exclusive rights under the patent laws. Were it otherwise patents might stifle, rather than promote, the progress of useful arts. See U.S. Const., Art. I, section 8, cl.8." In re KSR International Co. v. Teleflex Inc., 82 USPQ2d 1385 (U.S. 2007).

Claim 7. The constant velocity universal joint according to claim 1, wherein a consistency of said paste wax, which is measured according to the Japanese Industrial Standard,

Art Unit: 3679

is not less than 50 and less than 300, (in that the prior art wax structure is presumed to inherently have the applicant's claimed properties in accordance with MPEP 2112.01). Furthermore:

- Even if the prior art material did not inherently possess applicant's claimed properties, it appears that the claimed properties have no criticality. Wherein a specific limitation has no criticality, case law can be relied upon as the sole rationale in an obviousness rejection. See MPEP 2144.04. It has generally been recognized that selection of a known material based upon its suitability for the intended use is a design consideration within the skill of the art. In re Leshin, 227 F.2d 197, 125 USPQ 416 (CCPA 1960). Since the limitation has no criticality and has thus been established by the case law cited above to be an obvious design consideration within the skill of the art. "[T]he results of ordinary innovation are not the subject of exclusive rights under the patent laws. Were it otherwise patents might stifle, rather than promote, the progress of useful arts. See U.S. Const., Art. I, section 8, cl.8." In re KSR International Co. v. Teleflex Inc., 82 USPQ2d 1385 (U.S. 2007).

Claim 17. The constant velocity universal joint according to claim 1, wherein each of said plurality of roller members comprises a first flange (flange of 72 above 6) and a second flange section (flange of 72 below 6) formed on said inner diameter portion thereof, said first flange section being separated from said second flange section in the axial direction of said trunnions by an annular recess section (recess of 72 receiving 6).

*Response to Arguments*

Applicant's arguments with regard to the claim rejections have been fully considered but they are not persuasive.

Applicant argues that the amendments to the claims overcome the prior art. This is not persuasive. The prior art suggests all of applicant's claim limitations as is detailed in the reworded rejections above. Note especially that the newly added limitations to claims 1, 8, and 13-15 recite the consistency and chemical reactivity relative to elements (grease, boot, etc.) that are merely intended for use with the joint. The prior art joint is fully capable of use with any boot, grease, etc. including those that will be thicker and non-chemically reactive with the prior art wax. If applicant truly wishes to structurally limit the joint by a boot, grease, etc. then the claims must be amended to recite --a joint comprising a boot, grease, etc...--.

Applicant has previously argued that the prior art comprises intermediate products rather than final products since the prior art wax is removable. This is not persuasive. Applicant's claims do not recite wax that is unremovable. Similarly the claims do not require wax which does not readily blend with another lubricant. Furthermore applicant's own specification as originally filed details removal of wax after assembly (for instance claim 16 which now stands canceled).

Applicant has not demonstrated invention of any new type of wax. Nor has applicant set forth any new bearing structure. Rather applicant merely combines known waxes (solid and paste, such as parifin, etc., see specification, p.29) with a known bearing assembly for the known purpose of holding in place.



*Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Referring to past and solid wax:

US 20070105633 A1, paragraph 0102 on page 6

US 3231397

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, THIS ACTION IS MADE FINAL even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Art Unit: 3679

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor MacArthur whose telephone number is (571) 272-7085.

The examiner can normally be reached on 8:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (571) 272-7087. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197.

February 25, 2009

/Victor MacArthur/  
Primary Examiner, Art Unit 3679